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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/087,207  | 02/28/2002  | Patrick Jay Lutz     | 5408/11295-US2         | 7037             |
| 7278  | 7590        | 12/15/2004           | EXAMINER               |                  |
| DARBY & DARBY P.C.<br>P. O. BOX 5257<br>NEW YORK, NY 10150-5257 |             |                      | PRYOR, ALTON NATHANIEL |                  |
|   |             |                      | ART UNIT               | PAPER NUMBER     |
|   |             |                      | 1616                   |                  |
| DATE MAILED: 12/15/2004   |             |                      |                        |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/087,207

Applicant(s)

LUTZ, PATRICK JAY

Examiner

Alton N. Pryor

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1,5,21,24-28,31-43,46-56,62-66 and 76-88 is/are pending in the application.
- 4a) Of the above claim(s) 21,28,66,81 and 88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 47-55 is/are allowed.
- 6) ☐ Claim(s) 1,5,24-27,31-43,46,56,62-65,76-80,82-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

- I. Rejection of claims 24-27,39-42 under 35 USC 112, 2<sup>nd</sup> paragraph will not be maintained in light of amendment filed 10/27/04. Applicant provides antecedent basis for "aromatic carboxylic acid" in claim 82 from which claims 24-27,39-42 depend.
- II. Applicant's arguments filed 10/27/04 have been fully considered but they are not persuasive. See argument below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,5, 24-27,31-43,46,56,62-65,76-80,82-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adachi on record and Biedermann on record.

Adachi teaches a method of applying to skin (substrate) a composition comprising benzethonium chloride and salicylic acid to inhibit acne (microorganism). See abstract. Adachi does not teach the instant invention comprising hydroacetic acid and glycols. However, Biedermann teaches a method of applying a composition comprising hydroacetic acid and glycols to skin to treat acne by controlling sebaceous gland activity. See abstract, column 2 lines 33-38, column 3 line 45 – column 5 line 53, column 12 line 59 – column 12 line 12. It would have been obvious to one having ordinary skill in the art to modify the invention of Adachi to include dehydroacetic acid and glycols. One having ordinary skill in the art would have been motivated to do this

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since compositions comprising dehydroacetic acid and glycols treat acne by controlling sebaceous gland activity. With respect to the instant ratio of ingredients (hydroacetic acid : benzethonium chloride or salicylic acid : benzethonium chloride) the optimum ratios would have been determined through routine experimentation. One having ordinary skill in the art would have been motivated to do this in order to develop the most effective method for controlling the secretion of oils from the sebaceous gland to reduce acne. Applicant argues that compositions comprising 0.25% sodium dehydroacetate monohydrate or 0.10% hydroacetic acid and 0.50% benzene thonium chloride show unexpected results. Applicant refers Examiner to Example 1 or 2.

Examiner argues, while this may be true, Applicant does not claim a composition that recites this specific combination. Applicant is lacking results showing a wide range of said ingredients exhibiting synergism. Therefore, Examiner invites Applicant to amend independent claims to recite a composition comprising 0.25% dehydroacetate salt or 0.10% hydroacetic acid plus 0.5% benzethonium chloride. As an alternative, Examiner invites Applicant to submit a declaration showing synergistic results for a wide concentration ranges of dehydroacetic acids or hydroacetates in combination with benzethoniums.

III. Claims 47-55 are allowable for reason on record.

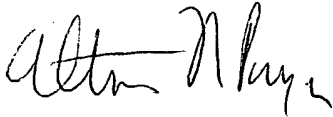
#### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alton Pryor', is written above the printed name.

Alton Pryor  
Primary Examiner  
AU 1616